

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 15

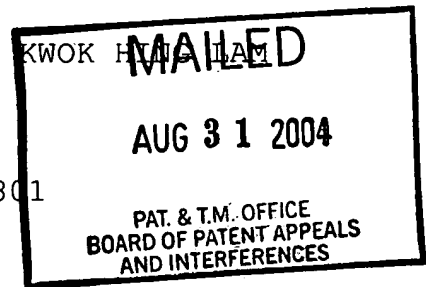
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

**Ex parte** DAVID ROBERT FENN and PETER KWOK HYUN LAM

Appeal No. 2004-1857  
Application No. 09/868,801

ON BRIEF



Before PAK, WARREN, and KRATZ, **Administrative Patent Judges**.  
PAK, **Administrative Patent Judge**.

**DECISION ON APPEAL**

This is a decision on an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1, 2, 4 and 6 through 11, which are all of the claims pending in the above-identified application.

**APPEALED SUBJECT MATTER**

The subject matter on appeal is directed to a liquid coating composition (otherwise known as "a polyurethane coating composition") containing diphenylmethane diisocyanate and a

particular hydroxy functional compound and a method of using the same. See the specification, pages 1-3 and 9. This liquid polyurethane composition is said to have a good pot-life and said to provide films having good properties. See the specification, page 3. As a result of these properties, the composition is said to be useful as a primer. **Id.** Further details of the appealed subject matter are recited in claims 1, 10 and 11 which are reproduced below:

1. A liquid coating composition consisting essentially of:

i) diphenylmethane diisocyanate; and

ii) a hydroxyl functional compound which is a polyester having secondary hydroxyl groups, the secondary hydroxyl groups being the product of a reaction between a carboxylic acid group and an epoxide group comprising a glycidyl ester of a C11-C20 alkanolic acid, the composition contains no reactive diluent which are aldimines, ketimines, or aspartic esters.

10. A process for preparing a liquid coating composition comprising the steps of mixing:

i) diphenylmethane diisocyanate, and

ii) a hydroxyl functional compound which is a polyester having secondary hydroxyl groups, the secondary hydroxyl groups being the product of a reaction between a carboxylic acid group and an epoxide group comprising a glycidyl ester of a C11-C20 alkanolic acid, optionally dissolved in organic solvent.

11. A process for coating a substrate which comprises the steps of: applying a layer of a liquid coating composition consisting essentially of:

i) diphenylmethane diisocyanate; and

ii) a hydroxyl functional compound which is a polyester having secondary hydroxyl groups, the secondary hydroxyl groups being the product of a reaction between a carboxylic acid group and an epoxide group comprising a glycidyl ester of a C11-C20 alkanolic acid, the composition contains no reactive diluent which are aldimines, ketimines, or aspartic esters to a surface of the substrate; and thereafter curing the layer of coating composition.

#### **PRIOR ART**

In support of his rejections, the examiner relies on the following prior art references:

Peng et al. (Peng)	4,322,508	Mar. 30, 1982
Chattha	4,379,906	Apr. 12, 1983
Van Den Elshout et al. (Elshout)	9201868 A	May 16, 1994
Aerts et al. (Aerts)	WO 96/20968	Jul. 11, 1996
(Published World Intell. Prop. Org. Application)		
Fenn	WO 97/30099	Aug. 21, 1997
(Published World Intell. Prop. Org. Application)		

#### **REJECTIONS**

The appealed claims stand rejected as follows:

1. Claims 1, 2, 4 and 6 through 11 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as their invention;

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2. Claims 1, 2, 4 and 6 through 11 under 35 U.S.C. § 102(b) as anticipated by the disclosure of either Fenn or Elshout; and
3. Claims 1, 2, 4 and 6 through 11 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of either Chattha, Peng or Aerts, and Fenn.

#### **OPINION**

We have carefully reviewed the claims, specification and applied prior art, including all of the arguments advanced by both the examiner and appellants in support of their respective positions. As a result of this review, we have made the determinations which follow.

#### **INDEFINITENESS**

As the court stated in *In re Moore*, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971), the determination of whether the claims of an application satisfy the requirements of the second paragraph of Section 112 is

merely to determine whether the claims do, in fact, set out and circumscribe a particular area with a **reasonable** degree of precision and particularity. It is here where the definiteness of the language employed must be analyzed -- not in a vacuum, but always in light of the teachings of the prior art and of **the particular application disclosure** as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. [Emphasis ours; footnote omitted.]

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The purpose of the second paragraph of Section 112 is to basically insure, with a **reasonable** degree of particularity, an **adequate** notification of the metes and bounds of what is being claimed. **See In re Hammack**, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970).

Here, the examiner criticizes the terminology "liquid coating composition," recited in claims 1, 10 and 11, but we do not believe that it can seriously be contended that the artisan would not understand "liquid coating composition" especially when it is read in light of pages 1-3 and 9 of the specification. The examiner cannot ignore the written description in the specification, which assists one of ordinary skill in the art in understanding the meaning of the claimed "liquid coating composition," i.e., a coating composition existing in liquid state for a certain time period at room temperature (i.e., a pot-life). Thus, we determine that the examiner has not established a **prima facie** case of unpatentability based on indefiniteness. Accordingly, we reverse the examiner's decision rejecting the claims on appeal under Section 112, second paragraph.

#### **ANTICIPATION**

Under Section 102(b), a prior art reference anticipates the claimed subject matter if it describes every feature of the claimed

invention, either explicitly or inherently. **See Hazani v. United States Int'l Trade Comm'n**, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997); **RCA Corp. v. Applied Digital Data Sys., Inc.**, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). The description of the claimed invention, however, must be clear and unequivocal such that it directs one of ordinary skill in the art to the claimed invention without any need for picking and choosing. **In re Schaumann**, 572 F.2d 312, 316-18, 197 USPQ 5, 8-10 (CCPA 1978); **In re Arkley**, 455 F.2d 586, 587, 172 USPQ 524, 526 (CCPA 1972).

Here, we find that neither Fenn nor Elshout clearly and unequivocally discloses the claimed subject matter. Thus, the examiner has not carried his or her initial burden of establishing a **prima facie** case of anticipation within the meaning of 35 U.S.C. § 102(b). **In re Oetiker**, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992) ([T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.")

First, the examiner has not established that one of ordinary skill in the art need not pick and choose specific polyisocyanates and specific hydroxyl functional compounds from the large number of

polyisocyanates and hydroxyl functional compounds listed at pages 3, 4 and 6 of Fenn and at pages 3-7 of Elshout to arrive at the claimed subject matter. As stated in **Arkley**, such picking and choosing may be proper in establishing obviousness under 35 U.S.C. § 103, but it has no place in establishing anticipation under 35 U.S.C. § 102(b).

Second, the examiner has not demonstrated that the powder coating composition described in Elshout is liquid and the liquid coating composition described in Fenn excludes aldimines, ketimines and aspartic esters. It may very well be obvious to provide the powder coating composition of Elshout in liquid form or replace aldimines, ketimines or aspartic esters with different amine reactive diluents in the liquid coating composition of Fenn. However, as indicated **supra**, anticipation requires that the claimed invention be described in a clear and unequivocal manner.

In view of the foregoing, we reverse the examiner's Section 102(b) rejection and remand the application to the examiner for appropriate action consistent with the instruction below.

Upon return of this application to the examiner's jurisdiction, the examiner is advised to determine whether Fenn alone, or Fenn with other prior art references, would have rendered the subject matter defined by claims 1, 2, 4 and 6 through 11 would

have been obvious to one of ordinary skill in the art within the meaning of 35 U.S.C. § 103. We find that Fenn alone would have **at least suggested** the subject matter defined by claim 10 on appeal. We find that Fenn discloses a liquid coating composition containing a polyisocyanate, a reactive diluent having amine groups or blocked amine groups and a hydroxyl functional compound. See page 3, lines 1-16. We find that Fenn goes on to list many polyisocyanates and hydroxyl functional compounds useful for its liquid coating composition. See pages 3 and 6. The polyisocyanates and hydroxyl functional compounds listed include the claimed diphenylmethane diisocyanate and the claimed hydroxyl functional compound formed by the claimed polycarboxylic acid with the claimed glycidyl esters. **Id.** The reactive diluent exemplified are aldimines, ketimines or aspartic esters. See pages 4 and 6. These reactive diluents are not excluded by claim 10 on appeal. However, since claims 1, 2, 4, 6 through 9 and 11 on appeal exclude aldimines, ketimines and aspartic esters, the examiner is to determine whether it would have been obvious to employ other amine reactive diluents for exemplified aldimines, ketimines and aspartic esters, in forming the liquid coating composition of Fenn.



**OBVIOUSNESS**

The examiner has rejected claims 1, 2, 4 and 6 through 11 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of either Chattha, Pang or Aerts, and Fenn. According to the examiner (Answer, page 6):

The primary references [Chattha, Pang and Aerts] disclose coating compositions derived from the reaction of a polyisocyanate crosslinking agent with a polyester containing secondary hydroxyl groups, derived from the reaction of compounds containing carboxyl groups with epoxides.

While the references teach the use of epoxides to produce the secondary group containing polyesters, the references are silent regarding the use of appellants' claimed glycidyl ester of C<sub>11</sub>-C<sub>20</sub> alkanolic acid as the epoxide. However, the use of such epoxides to produce secondary group containing polyesters for use within isocyanate cured coating compositions was known at the time of invention. This position is supported by the teachings of WO 97/30099 at page 6, lines 35-37.

Therefore, the position is taken that it would have been obvious to utilize the claimed epoxide within the primary references, so as to arrive at the instant invention, because it has been held that it is *prima facie* obvious to utilize a component for its known function. In re Linder, 173 USPQ 356. In re Dial et al., 140 USPQ 244. One would have reasonably expected the use of the claimed epoxide to yield compositions having properties analogous to the properties of the compositions of the primary references.

As is apparent from the above statements, the examiner has not identified any particular sections (columns and lines or pages and lines) of the primary references which are said to teach and/or suggest features corresponding to the claimed subject matter. **See**

37 CFR § 1.104(c)(2)(2002). Nor has the examiner explained why one of ordinary skill in the art would have been led to employ the claimed glycidyl ester described in Fenn as the epoxide of the primary references, without adding the reactive diluent of the type described in Fenn. Thus, we remand this application to the examiner to clarify his Section 103 rejection as indicated *supra*.

Rather than remanding the application to the examiner, our colleague proposes reasoning materially different from the one proposed by the examiner based on Fenn alone to affirm the examiner's Sections 102 and 103 rejections. However, such new rejections are not properly before us since the appellants had no opportunity to respond to them. As such, we decline to subscribe to our colleague's position.

#### **CONCLUSION**

In summary:

- 1) The examiner's Section 112 rejection is reversed;
- 2) The examiner's Section 102(b) rejection is reversed; and
- 3) The application is remanded to the examiner to clarify his Section 103 rejection of record and determine whether Fenn alone or Fenn in combination with other prior art references would have rendered the claimed subject matter obvious. We do not authorize the examiner to submit a Supplemental Answer under 37 CFR

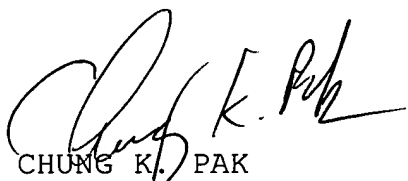
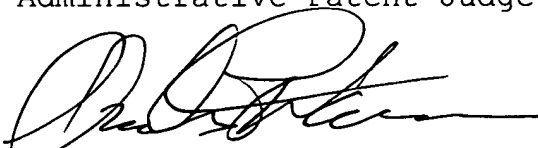
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§ 1.193(b)(1)(2002). In other words, the examiner must reopen the prosecution of this application to implement a new ground of rejection based on Fenn alone or Fenn in combination of other prior art references.

This application, by virtue of its "special" status, requires immediate action. **See Manual of Patent Examining Procedure (MPEP)** 708.01 (8<sup>th</sup> Ed., Rev. 1, Feb. 2003). It is important that the Board be informed promptly of any action affecting the appeal in this application.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

**REVERSED/REMANDED**

	)	
CHUNG K. PAK	)	
Administrative Patent Judge	)	
	)	
CHARLES F. WARREN	)	
Administrative Patent Judge	)	
	)	BOARD OF PATENT
	)	APPEALS AND
	)	INTERFERENCES

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KRATZ, **Administrative Patent Judge**, concurring-in-part and dissenting-in-part.

I concur with the majority's disposition of the examiner's Section 112, second paragraph rejection of claims 1, 2, 4 and 6-11. Moreover, I concur with the majority's decision to reverse the examiner's Section 102 (b) rejection of claims 1, 2, 4 and 6-11 as being anticipated by Elshout.

However, I respectfully disagree with the majority's decision to reverse the examiner's Section 102(b) rejection of claims 1, 2, 4 and 6-11 as being anticipated by Fenn. Also, I respectfully disagree with the majority's decision to reverse the examiner's Section 103(a) rejection of claims 1, 2, 4 and 6-11 as being unpatentable over the combined disclosures of either Chattha, Peng or Aerts, and Fenn.

At the outset, it is noted that appellants state that "[a]ll of the claims on appeal stand or fall together (brief, page 3). Accordingly, I would select claim 10 as representative of rejected claims 1, 2, 4 and 6-11 and would have decided this appeal as to the examiner's Section 102(b) and Section 103(a) rejections on the basis of that representative claim. **See** 37 CFR § 1.192(c)(7) and (c)(8)(2002) and **In re McDaniel**, 293 F.3d 1379, 1383, 63 USPQ2d

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1462, 1465 (Fed. Cir. 2002) ("If the brief fails to meet either requirement, the Board is free to select a single claim from each group of claims subject to a common ground of rejection as representative of all claims in that group and to decide the appeal of that rejection based solely on the selected representative claim").

Concerning the Section 102(b) rejection, it is noted that "[t]o anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently." **In re Schreiber**, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997); **accord Glaxo Inc. v. Novopharm Ltd.**, 52 F.3d 1043, 1047, 34 USPQ2d 1565, 1567 (Fed. Cir. 1995).

However, the law of anticipation does not require that the reference teach what the appellants are claiming, but only that the claims on appeal "read on" something disclosed in the reference (**see Kalman v. Kimberly-Clark Corp.**, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983)).

Anticipation under this section is a factual determination. **See In re Baxter Travenol Labs.**, 952 F.2d 388, 390, 21 USPQ2d 1281, 1283 (Fed. Cir. 1991) (citing **In re Bond**, 910 F.2d 831, 833, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990)).

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In the case before us, the examiner has determined that the appealed claims read on the subject matter described by Fenn. In this regard, we note that appellants do not present any specific arguments against the examiner's anticipation determination concerning the correspondence of the coating composition preparation method described in Fenn and that of representative claim 10 but for the assertion that Fenn requires use of a reactive diluent that is not part of appellants' composition preparation method and resultant product coating composition.

However, representative claim 10 does not exclude a reactive diluent as employed by Fenn from being used in the claimed method of preparing a coating composition. In this regard, it is noted that the term "comprising" as used in representative claim 10 leaves the claimed method open to the inclusion of using other ingredients in the composition preparation method.

It follows that, on this record, I would affirm the examiner's Section 102(b) rejection of claims 1, 2, 4 and 6-11 as being anticipated by Fenn.

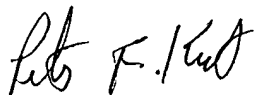
Turning to the examiner's Section 103(a) rejection, it is noted that the only focused argument presented in appellants' brief respecting that rejection over the combination of Fenn with any of three other references is essentially directed at Fenn. Appellants

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basically maintain that Fenn allegedly teaches using a reactive diluent having amine or blocked amine groups that must be employed in the composition preparation method. Thus, in appellants' view, the combination of applied references would not suggest a composition preparation method that is in accord with the claimed invention.

However, as pointed out above, representative claim 10 is not limited in a fashion so as to exclude using a diluent having amine or blocked amine groups as employed by Fenn in a process of preparing a coating composition.

Consequently, on this record, I would affirm the examiner's Section 103(a) rejection of claims 1, 2, 4 and 6-11 as being unpatentable over the combined disclosures of either Chattha, Peng or Aerts, and Fenn.

  
PETER F. KRATZ ) BOARD OF PATENT  
Administrative Patent Judge ) APPEALS  
 ) AND  
 ) INTERFERENCES

CKP/PFK:hh

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